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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,820	12/14/2000	Hao A. Chen	3620-036-01	8675

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Luke A. Kilyk, Esq.  
KILYK & BOWERSOX, P.L.L.C.  
3603-E Chain Bridge Road  
Fairfax, VA 22030

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/25/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	09/736,820		CHEN ET AL.	
	Examiner		Art Unit	
	Jane J Rhee		1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 7-18, 21, 24-26 and 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 19-20, 22-23, 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 19-20, 22-23, and 27, are drawn to the article, classified in class 427, subclass 57.
- II. Claims 7-18, 21, 24-26, 28-30 are drawn to the method, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as welding.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Kilyk on January 14, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6, 19-20, 22-23, and 27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-18, 21, 24-26, and 28-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. The term "laminate" in claim 23 is a relative term which renders the claim indefinite. The term "laminate" is not defined by the claim; the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "capable" in claims 1 and 19 is a relative terms which renders the claim indefinite. The term "capable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being unpatentable by Peralt Anstalt (1178565).

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Peralt Anstalt discloses a surface covering comprising two or more polymeric planks having edges, wherein the planks are connected to each other by a bonding agent, wherein the bonding agent is present on at least one of the edges of at least one of the planks, and wherein the bonding agent comprises at least one solvent capable of at least bonding the edges of the planks (col.1 lines 17-22). Peralt Anstalt discloses that the bonding agent consists of tetrahydrofuran (col. 1 line 30-31). Peralt Anstalt discloses that the surface covering wherein the bonding agent comprises tetrahydrofuran, cyclohexanone, methylene chloride, dimethyl formamide, toluene, acetone, ethylene dichloride, methyl ethyl ketone, n-methyl pyrrolidone, methyl isobutyl ketone, dipropyl ketone, isophorone, methyl amyl ketone, nitrobenzene, methyl cyclohexanone, acetonyl acetone, or combinations thereof (col. 1 line 30-31). Peralt Anstalt discloses that the bonding agent is present on at least each edge of each thermoplastic plank connected together to another thermoplastic plank (col. 1 lines 17-22). Peralt Anstalt discloses that the bonding agent is present on two opposite edges of each plank (col. 1 lines 17-22).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peralt Anstalt in view of Del Rincon et al.(5694730).

Peralt Anstalt discloses a surface covering as described above. Peralt Anstalt fails to disclose splines located between at least a portion of the polymeric planks, wherein at least a portion of the planks and splines are connected to each other by a bonding agent comprising at least one solvent capable of bonding at least the spline and plank together, wherein the bonding agent is applied to at least one of the edges of at least one of the individual planks, splines, or both. Del Rincon et al. teaches splines located between at least a portion of the polymeric planks for the purpose of joining the planks together (col. 1 line 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Peralt Anstalt with a spline that is located between at least a portion of the polymeric planks in order to join the planks together as taught by Del Rincon et al (col. 1 line 5).

4. Claims 22, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peralt Anstalt in view of Boultinghouse (4666549).

Peralt Anstalt discloses a surface covering as described above. Peralt Anstalt discloses that the polymeric plank has a polymeric core with a laminate affixed on the surface of the core (col. 1 line 12). Peralt Anstalt fails to disclose that the polymeric plank is in the shape of a tile. Peralt Anstalt fails to disclose that the bonding agent comprises at least two different solvents capable of at least bonding the edges of the polymeric portion of the plank. Boultinghouse teaches that the bonding agent comprises at least two different solvents capable of at least bonding the edges of the

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polymeric portion of the plank for the purpose of providing a permanently welded resinous block copolymer (col. 1 line34).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided Peralt Anstalt with a bonding agent comprises at least two different solvents capable of at least bonding the edges of the polymeric portion of the plank for the purpose of providing a permanently welded resinous block copolymer (col. 1 line34) as taught by Boultinghouse.

It would have been an obvious matter of design choice to make the plank in to the shape of a tile, since such modification would have involved a mere change in the shape of the component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-301-9999 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jane Rhee  
February 22, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

2/22/02